

**DRAFT**



**GEOGRAPHICAL INDICATION ACT OF LIBERIA, 2014**

# **GEOGRAPHICAL INDICATIONS ACT, OF LIBERIA**

It is enacted by the Senate and House of Representatives in Legislature Assembled:

## **PART I**

### **PRELIMINARY PROVISIONS**

#### **§1.1. Short Title**

This Act may be cited as “Liberia Geographical Indications Act”.

#### **§1.2. Definitions**

Unless the context otherwise requires,

“Geographical indication” means an indication which identifies a good as originating in the Territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin;

“good” means any natural or agricultural product or any product of handicraft or industry;

“producer” means:

- (i) any producer of agricultural products or any other person exploiting natural products; and
- (ii) any manufacturer of products of handicraft, or industry.

“Register” means the principle register of geographical indications; and

“Registrar” means the registrar of intellectual property.

**PART II**  
**PROTECTIONS**

**§2.1. Civil Proceedings**

Any interested person may institute proceedings in the court to prevent, in respect of geographical indications:

(a) the use of any indication or device in the presentation of a good in the course of trade that suggests that the good in question originates in a geographical area other than its true place of origin in a manner which misleads the public as to the geographic origin of the good,

(b) any use that would constitute an act of unfair competition under the Unfair Competition Act of Liberia; or

(c) any use of a geographical indication for goods not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by waivers, de-localizing clarifications or expressions such as “kind”, “type”, “style”, “imitation” or others of similar effect.

**§2.2. Availability of Protection Regardless of Registration; Presumption**

(a) Protection under this Act shall be available regardless of whether a geographical indication has been registered. However, registration of a geographical indication under this Act shall, in any proceedings, raise a presumption that such indication is a geographical indication..

(b) Protection under this Act shall be available against another geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

**§2.3. Homonymous Geographical Indications**

(a) In the case of homonymous geographical indications for identical products, protection under this Act shall be available against another geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory .

(b)The Director General may allow homonymous geographical indications to be concurrently registered if he is satisfied that the public will not be misled. In case of permitted concurrent use

of such indications, the Director General shall determine the practical conditions under which the homonymous indications will be differentiated, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled and issue appropriate legislation.

(c) In the case of homonymous geographical indications for wines, protection shall be accorded to each indication.

#### **§2.4. Exclusion from Protection**

The following shall not be protected as geographical indications:

(a) an indication that does not comply with the definition of geographical indication in Section 1.2 of this Act;

(b) an indication the use of which must be prevented on grounds of public order or morality;

(c) a geographical indication that is not, or that ceases to be, protected in its country of origin, or which has fallen into disuse in that country;

(d) an indication that is identical with the term customary in common language in Liberia as the common name for the relevant goods or for related services.

#### **§2.5. Application for Registration; Right to File Application**

(a) An application for the registration of a geographical indication shall be filed with the Director General.

(b) The following shall have the right to file an application for registration of a geographical indication:

(i.) a grouping of producers or a legal entity that groups producers that operate in a specified geographical area and with respect to specified goods;

(ii.) any competent authority on behalf of the persons or the legal entity indicated under subsection (i.) of this section.

## **§2.6. Content of Application**

- (a) An application for the registration of a geographical indication shall specify:
- (i.) the name, address and domicile of the persons or legal entity filing the application;
  - (ii.) the geographical indication for which registration is sought;
  - (iii.) the geographical area to which the geographical indication applies;
  - (iv.) the goods designated by the geographical indication.
- (b) The application shall be accompanied by a specification describing in sufficient detail the specific characteristics of the goods for which the geographical indication is used, the area and method of production of the goods, the link between the characteristics of the goods and the area and method of production, the manner in which the specified characteristics are controlled and other prescribed particulars, and shall be subject to the payment of the prescribed fee.
- (c) The application shall indicate the manner in which the continued compliance of the conditions laid down in the specification will be controlled by an independent body or authority.

## **§2.7. Examination; Publication; Opposition and Registration**

- (a) The Director General shall examine whether the application complies with the requirements of Section 2.4, Section 2.5 (b) and Section 2.6 and the Regulations pertaining thereto.
- (b) Where the Director General finds that the conditions referred to in subsection (a) of this section are fulfilled; he shall cause the application to be published in the prescribed manner.
- (c) Any interested person or competent authority may, within the prescribed period and in the prescribed manner, give notice to the Director General of opposition to the registration of the geographical indication specifying the grounds of the opposition.
- (d) The Director General shall publish a notice of the opposition in the Official Gazette, and, within the period of three months and in the prescribed manner, the applicant shall send to the Director General a counter-statement of the grounds on which he relies for his application.
- (e) If the applicant sends a counter-statement, the Director General shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the geographical indication should be registered.

(f) Where the Director General finds that the conditions referred to in subsection (a) of this section are fulfilled he shall register the geographical indication, publish a reference to the registration and issue to the applicant a certificate of registration. Otherwise, he shall refuse the application.

## **§2.8. Scope of Exclusive Rights**

(a) Only producers carrying on their activity in the geographical area specified in the Register shall have the right to use a registered geographical indication, in the course of trade, with respect to the products specified in the Register.

(b) For the purposes of this section, the following acts, in particular, shall be regarded as use of a geographical indication in the course of trade:

(i.) introducing on the market, selling, offering for sale or distributing goods or services with the geographical indication or with reference to the geographical indication;

(ii) importing, exporting, storing or transporting goods that bear the geographical indication or that refer to the geographical indication;

(iii) using the geographical indication in advertising, publications, business papers, commercial documents or written or oral communications, irrespective of the means of communication or media used;

(v) using the geographical indication for commercial purposes on the Internet or other electronic communication media or networks open to the public where such use is intended for Liberia or has a commercial effect in Liberia;

(v) adopting or using the geographical indication as part of a domain name or other similar identification or designation on the internet or other electronic communication media or networks open to the public.

## **§2.9. Limitations and Exceptions**

(a) The rights conferred by registration of a geographical indication may not be exercised to prevent:

(i.) any acts in respect of goods lawfully bearing the geographical indication after those goods have been put on the market in Liberia or abroad by the registered holder or by a person acting with the holder's consent or having an economic tie to the holder, provided that the goods and the packaging or wrapping in direct contact with the goods have not suffered any material alteration or damage; to this effect an economic tie shall exist between two persons where one of them may exercise on the

other a decisive influence with respect to the exploitation of the geographical indication, or where a third party may exercise such an influence on both persons;

(ii.) use of the registered geographical indication by any person for the purpose of indicating truthfully in the course of trade that the goods or services that bear the geographical indication originate with the holder of the geographical indication or a licensee thereof;

(iii.) use of the registered geographical indication by any person to provide information regarding the intended purpose, use or compatibility of a product or service, in particular with respect to accessories or spare parts;

(iv.) use of indications concerning the kind, quality, quantity, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services;

(v.) use by a person in the course of trade of that person's name, address, place of business or place of production or distribution of goods or services, or those of that person's predecessor in business.

(vi) The acts under subsection (a)(ii.) , (iii.), iv, and (v) shall be allowed subject to compliance with honest practices and provided such acts do not cause confusion regarding the provenance of the goods or services, and do not take unfair advantage of, or are detrimental to, the distinctive character or repute of the mark, and do not otherwise constitute unfair competition.

(b) Where a mark has been applied for or registered in good faith, or where rights to a mark have been acquired through use in good faith either:

(i.) before the date of entry into force of this Act; or

(ii.) before the geographical indication is protected in its country of origin;

the registrability or the validity of the registration of that mark, or the right to use that mark, shall not be affected on grounds that such mark is identical with, or similar to, a geographical indication.

(c) Nothing in this Act shall prevent continued and similar use in Liberia of a particular foreign geographical indication by any national or domiciliary of Liberia who has used that geographical indication in connection with goods or services in the territory of Liberia, in a continuous manner with regard to the same or related goods or services, either:

(i.) for at least 10 years preceding April 15, 1994; or

(ii.) in good faith at any time prior to that date.

## **§2.10. Invalidation, Revocation and Amendment of Registration**

(a) Any interested person or any competent authority may request the Director General to order:

- (i.) the invalidation of a registration of a geographical indication on the ground that the registered indication did not qualify for protection as such under this Act;
- (ii.) the revocation of a registration of a geographical indication on the ground that the registered indication is used in a manner that does not correspond to the specifications of the products designated by the indication; or
- (ii.) the amendment of a registration of a geographical indication where the specifications recorded in the register need to be corrected.

(b) In any proceedings under this section, the Director General shall cause a notice of the request:

- (i.) to be served on the persons who filed the application for registration of the geographical indication; and
- (ii.) to be given by publication in the Official Gazette to all persons having the right to use the registered geographical indication.
- (iii.) The persons referred to in subsection (b) of this section and any other interested person may, within a period, which shall be specified by the Director General in the said notice, apply to join in the proceedings.

## **§2.10. False Indication: Seizure on Importation**

Where there is direct or indirect use of a false indication of the source of the goods or the identity of the producer or manufacturer or merchant, all goods affected shall be subject to seizure upon importation into Liberia pursuant to the Customs Law.

## **§2.11. Regulations; Administrative Instructions**

(a) Regulations shall be issued on trademarks by the Director General of the Office to further implement this Act and which shall include general provisions pertaining to:

- (i.) Border Measures;
- (ii.) Changes in Ownership;

- (iii.) Licenses/compulsory licenses;
- (iv.) Correction of errors;
- (v.) Extension of time;
- (vi.) The register;
- (vii.) Official Gazette;
- (viii.) Exercise of discretionary powers;
- (ix.) Representation;;
- (x.) Competence of the court;
- (xi.) Appeals.

### **PART III**

#### **ENFORCEMENT OF RIGHTS AND LEGAL PROCEEDINGS**

##### **§3.1. Infringement of Geographical Indications; Remedies**

(a) A geographical indication protected under this Act shall be infringed by the performance of any act referred to in §2.8(a) or any use of a geographical indication by a party who does not have the right to use the geographical indication in accordance with this Act, subject to the limitations and exceptions provided for in §2.8(b).

(b) On the request of any interested person or of any interested group of producers or consumers, the court may grant an injunction to prevent the unlawful use of the geographical indication, award damages and grant any other remedy provided for in the general law or under this Act.

### **§3.2. Provisional Measures**

(a) All provisional remedies under the Civil Procedure Law of Liberia including injunctions shall be applicable to civil proceedings relating to geographical indications primarily to prevent an infringement from occurring and preserve relevant evidence in regard to the alleged infringement;

(b) Time limitations for action for damages under the Civil Procedure Law of Liberia shall be applicable to geographical indications.

(c) The aggrieved party's entitlement to compensation shall be pursuant to the Civil Procedure Law of Liberia.

### **§3.3. Evidence**

(a) Any party to proceedings relating to geographical indication infringement shall be governed by the provisions of the Civil Procedure Law relative to evidence including burden of proof, the right to compel production of documents and to designate documents as privileged or confidential.

(b) Any registration issued under this Act of a geographical indication registered on the principal register for geographical indication and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered geographical indication and of the registration of the geographical indication, of the registrant's ownership of the geographical indication, and of the registrants' exclusive right to use the geographical indication.

### **§3.4. Damages**

(a) An aggrieved party to proceedings involving geographical indication may seek and obtain a court order that the infringer pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity, inclusive of expenses such as attorney fees, or an order for the recovery of profits and or payment of pre-established damages where the infringer with reasonable grounds to know engaged in infringing activity.

(b) An order may also be sought and obtained that the infringer to inform the holder of the right of the identity of third persons involved in the production and distribution of the infringing goods or rendering of services and of their channels of distribution, where this would be in proportion to the seriousness of the infringement.

### **§3.5. Indemnification of Defendant**

Any party to lay-out design proceedings who abuses enforcement proceedings may be required by Court order to indemnify the defendant for injury suffered for such an abuse pursuant to the

Civil Procedure Law of Liberia.

### **§3.6. Unfair Competition**

Unfair competition legislation in Liberia prohibiting dishonest practices in industrial or commercial matters shall be applicable to geographical indication.

### **§3.7. Appeals**

(a) An applicant for registration of a geographical indication, party to an opposition proceeding, or applicant for renewal or other infringement proceedings who is dissatisfied with the decision of the Director General may appeal to the courts.

(b) The appeal shall follow the procedure provided under the Civil Procedure Law of the Republic of Liberia.

### **§3.8. Further Sanctions**

When a person has been found liable for infringement under this Act, to create an effective deterrent to further infringement, the infringer may be subjected to a court order for seizure, forfeiture or disposal of the infringing goods and of any materials and instruments the predominant use of which have been in the commission of the infringement.

## **PART IV**

### **OFFENSES**

#### **§4.2. Misleading as to origin**

A person is guilty the offense of misleading as to origin, which shall constitute a felony of the second degree under the Penal Law of Liberia, who:

- (a) Uses any means in the designation or presentation of goods that indicates or suggests that the goods in question originate in a geographical area other than the true place of origin in a manner to mislead the public as to the geographical origin of the goods.or
- (b) Uses a geographical indication which identifies wines for wines not originating in the place indicated by the geographical indication in question or identifies spirits for spirits not originating in the plae indicated by the geographical indication in question, even whwere the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “style”, “imitation” or the like.

#### **§4.2. Fraud in relation to registers**

A person is guilty of the offense of fraud in relation to registers, which shall constitute a felony of the second degree under the Penal Law of Liberia, who:

- (a) makes or causes to be made a false entry in a register for geographical indication maintained by the Liberia Intellectual Property Office; or
- (b) makes or causes to be made a writing falsely purporting to be a copy of an entry in any such register; or
- (c) produces or tenders or causes to be produced or tendered as evidence any such entry or copy thereof knowing it to be false.

#### **§4.3. False statement for the purpose of deceiving**

A person is guilty of the offense of false statement for the purpose of deceiving or influencing the Director General, the Registrar or other officer of the Liberia Intellectual Property Office, which shall constitute a felony of the second degree, who makes a false statement for the purpose of:

- (a) deceiving the Director General, the Registrar or any officer in the execution of the provisions of this Act;
- (b) procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder; or
- (c) makes a false representation knowing it to be false.

#### **§4.4. Falsely representing geographical indication as registered**

A person is guilty of falsely representing a geographical indication as registered, which shall constitute a felony of the second degree, under the Penal Law of Liberia, who:

- (a) makes a representation with respect to a geographical indication not being a registered geographical indication, to the effect that it is a registered geographical indication;
- (b) makes a representation that a registered geographical indication is registered in respect of any goods or services in respect of which it is not registered;
- (c) makes a representation that the registration of a geographical indication gives an exclusive right to the use thereof in any

circumstances in which, having regard to limitations entered in the register, the registration does not give that right.

This Act shall take effect immediately upon publication in handbills by the Ministry of Foreign Affairs.

ANY LAW TO THE CONTRARY NOTWITHSTANDING